

### **REMARKS**

Prior to the mailing of the Office Action on March 23, 2005, claims 1-33 were pending. The above Amendments to the Claims cancels no claims, amends claims 1, 20, 26, and 32, and adds claims 34-38. Claims 24, 25, and 33 have been withdrawn. Therefore, claims 1-23, 26-32, and 34-38 are currently pending.

#### **Election of Group I Claims**

On page 2 of the Office Action the Examiner indicated an Election between the claims of Group I and Group II was required. Applicants have elected to pursue the claims of Group I including claims 1-23 and 26-32. Please withdraw the claims of Group II from further consideration including claims 24, 25, and 33.

#### **Amendments to the Specification**

On pages 3-4 of the Office Action the Examiner indicated the Abstract of the disclosure was objected to because of the phrase "is disclosed" in lines 1 and 2 of the Abstract. Applicants have submitted an amended Abstract herewith correcting this informality.

On page 4 of the Office Action the Examiner indicated that Page 6, Line 11 of the Specification contained an informality in which "the second aperture" was incorrectly labeled with reference numeral 54. An amended paragraph has been submitted herewith in which this informality has been corrected.

#### **35 U.S.C. § 112 Rejections of Claims 1-21 and 26-32**

On page 4 of the Office Action the Examiner rejected claims 1-21 and 26-32 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter regarded as the invention. In regard to each of independent claims 1, 20, 26, and 32, the Examiner states that "the member" has a claimed first position and a claimed second position. However, the Examiner asserts it is not clear what the Applicant is trying to claim.

Applicants have amended each of independent claims 1, 20, 26, and 32 to further clarify these claims. The claims now clearly indicate that the lock assembly has a first configuration

when mounted in a right hand door and a second configuration when mounted in a left hand door. The member is in a first position or a second position based upon the lock assembly being in either the first configuration or second configuration.

Applicants submit each of the amended independent claims and all of the claims that depend from them now distinctly claim the subject matter which Applicants regard as the invention. Withdrawal of each of the rejections under 35 U.S.C. § 112 is respectfully requested.

Rejection of Claim Under 35 U.S.C. § 103 (a)

At page 5 of the Office Action the Examiner rejects claims 1-10, 17, 18, 20-29, and 32 under 35 U.S.C. § 103 (a) as being unpatentable over U.S. Patent No. 4,671,089 to Fleming et al. (Fleming '089) in view of U.S. Patent No. 4,671,089 to Fleming et al. (Fleming '144).

Applicants submit that the Examiner has not presented a *prima facie* case of obviousness. As such, the rejection is improper. It is the burden of the Patent and Trademark Office to establish a *prima facie* case of obviousness when rejecting claims under 35 U.S.C. §103. *In re Reuter*, 210 U.S.P.Q.2d 249 (CCPA 1981). To establish a *prima facie* case of obviousness, three basic criteria must be met: first, there must be some suggestion, incentive or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings; second, there must be a reasonable expectation of success; and third, the prior art references must teach or suggest all the claim limitations. *In re Geiger*, 815 F.2d 686, 688 (Fed. Cir. 1988). Furthermore, the teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in the Applicants' disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991).

The cited references individually do not teach Applicants' invention, and there is no motivation to combine these references. For such a rejection to be proper there must be some reason, suggestion, or motivation found in the prior art whereby a person of ordinary skill in the field of the invention would make the modification suggested by the Examiner. That knowledge cannot come from the Applicants' invention itself. *In re Oetiker*, 977 F.2d 1443, 1447 (Fed. Cir. 1992). Further, "the mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability

of the modification.” *In re Fritch*, 972 F.2d 1260, 1266 (Fed. Cir. 1992). Thus, modification of Fleming ‘089 in view of Fleming ‘144 in a manner that apparently reconstructs Applicants’ invention is improper and insufficient to present a *prima facie* case of obviousness.

It is improper to combine the Fleming ‘089 and Fleming ‘144 references in the manner suggested. On page 5 of the Office Action, the Examiner stated that the Fleming ‘089 reference discloses a device 10 for operating a lock assembly 84 comprising a member 87 that is structure adapted to cooperate with the lock assembly; a handle 26 operable and adjustable and connected to the member; and an adapter 101 connecting the member with the handle.

However, the Fleming ‘089 reference discusses a combination latch mechanism 12 and deadbolt mechanism 16. Column 3, lns. 65-67. The lock assembly 84 comprising a member 87 is a part of the deadbolt mechanism 16. Col. 7, lns. 3-11.

Conversely, the Fleming ‘144 reference does not include a deadbolt, but rather a hook-shaped latch 38 for releasably engaging and locking with a conventional mating keeper. Col. 5, lns. 12-14. Therefore the references disclose distinct structures and there is no motivation or suggestion to combine the deadbolt mechanism of Fleming ‘089 with the latching mechanism of Fleming ‘144 present.

Even if such motivation or suggestion did exist, all of the elements of the rejected claims are not taught by the combination of the cited references. Specifically, claim 1 of the present application includes, among other things, “the first position of the handle when the member is in the first position is the same as the first position of the handle when the member is in the second position.” This element is not shown in Fleming ‘144 contrary to the Examiner’s indication.

In Fleming ‘144 the latch lever 18 is reversibly mounted onto the inside escutcheon 28. Col. 8, lns. 16-17. When the door handle and lock assembly of Fleming ‘144 is mounted on the right side of a door, the latch lever 18 is in a first position, and when this door handle and lock assembly is mounted on the left side of a door the latch lever 18 is reversed, or in other words, flipped over. (See FIGS. 1 and 24). This means the latch lever 18 is necessarily not in the same position, as it has been turned over.

As discussed in the application it is desirable for the handle to have the same position in the locked and unlocked positions regardless of if it is installed on a left hand door or a right hand door. The cited references are not capable of this claimed feature.

For these reasons, Applicants submit claim 1 is patentably distinct from the suggested combination of Fleming '089 with Fleming '144.

Claims 2-10, 17, and 18 each depend, directly or indirectly, from claim 1 and include all limitations thereof. Therefore, each of claims 2-10, 17, and 18 is also patentably distinct from the suggested combination of Fleming '089 with Fleming '144.

Independent claim 20 stands rejected under §103 in view of the combination of Fleming '089 with Fleming '144. Amended claim 20 includes, among other things, "the first position of the handle when the member is in the first position is the same as the first position of the handle when the member is in the second position." Applicants submit claim 20 is allowable for the same reasons as discussed above with respect to amended claim 1.

Claim 21 depends from claim 20 and includes all limitations thereof. Therefore, claim 21 is also patentably distinct from the suggested combination of Fleming '089 with Fleming '144.

Likewise, independent claim 22 includes, among other things, wherein "the first position of the handle when the member is adapted to be connected to the lock assembly in the first configuration is the same as the first position of the handle when the member is adapted to be connected to the lock assembly in the second configuration." Independent claim 26 includes, among other things, wherein "the first position of the handle when the member is in the first position is the same as the first position of the handle when the member is in the second position." Independent claim 32 includes, among other things, wherein "the first position of the handle when the tailpin is in the first position is the same as the first position of the handle when the tailpin is in the second position." Applicants submit each of these claims 22, 26, and 32 is allowable for the same reasons as discussed above with respect to amended claim 1.

Claims 23 and 27-31 ultimately depend from claims 22 and 26, respectively, and include all limitations thereof. Therefore, these claims are also patentably distinct from the suggested combination of Fleming '089 with Fleming '144.

At page 6 of the Office Action the Examiner rejects claims 11-16 under 35 U.S.C. § 103 (a) as being unpatentable over Fleming '089 in view of Fleming '144 in further view of U.S. Patent No. 4,453,753 to Fayerman et al.

Claims 11-16 ultimately depend from claim 1, and are patentably distinct from the suggested combination of Fleming '089 with Fleming '144 for the reasons discussed above with

respect to claim 1. Fayerman fails to rectify the shortcomings of the other cited prior art, and there is no suggestion to combine Fayerman with the other cited references. Therefore, Applicants submit each of claims 11-16 is in a condition for allowance.

At page 7 of the Office Action the Examiner rejects claims 19, 30, and 31 under 35 U.S.C. § 103 (a) as being unpatentable over Fleming '089 in view of Fleming '144 in further view of U.S. Patent No. 299,633 to Flinn.

Claim 19 depends from claim 1, and is patentably distinct from the suggested combination of Fleming '089 with Fleming '144 for the reasons discussed above with respect to claim 1. Flinn fails to rectify the shortcomings of the other cited prior art, and Applicants submit claim 19 is also in a condition for allowance.

Claims 30 and 31 ultimately depend from claim 26, and are patentably distinct from the suggested combination of Fleming '089 with Fleming '144 for the reasons discussed above with respect to claim 26. Flinn fails to rectify the shortcomings of the other cited prior art, and Applicants submit claims 30 and 31 are also in a condition for allowance.

In addition, no motivation or suggestion to combine Flinn with either Fleming '089 or with Fleming '144 has been shown. As previously noted, Fleming '089 discusses a combination latch mechanism 12 and deadbolt mechanism 16. Fleming '144 discusses a hook-shaped latch 38 for releasably engaging and locking with a mating keeper. Flinn has nothing to do with either of these devices.

In Flinn, an improved door-knob is disclosed. The improvement to the door-knob is an increased number of holes in a shank for attaching a knob to the shank. The increased number of holes allows for doors of different thicknesses. Col. 1, Ins. 40-47. No suggestion from which one of ordinary skill in the art would be motivated to combine the teachings of Flinn into a latch mechanism, deadbolt, or hook-shaped latch is present.

Even if such a suggestion or motivation was present in the cited prior art, the Flinn reference still fails to teach each element of claim 19. In claim 19, the member includes a member first position and a member second position. However, in Flinn the shank, does not move from position to position. Rather, the knob is moved along a stationary shank to adjust for doors of differing thickness. Because the shank does not move, it cannot have a first position and second position as required by claim 19.

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For these reasons, Applicants submit claims 19, 30, and 31 are patentably distinct from the suggested combination of Fleming '089 with Fleming '144 in further view of Flinn.

New Claims 34-38

The above Amendments also adds new claims 34-38. Applicants submit that none of the references of record, alone or in combination, disclose or suggest the subject matter required by claims 34-38.

Therefore, Applicants submit that each of the pending claims is in allowable form and respectfully requests notice of same.


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**CONCLUSION**

Applicants submit the application is in condition for allowance. Such allowance is respectfully requested. The Examiner is also requested to contact the undersigned if the Examiner has any questions concerning this Reply or if it will expedite the progress of this application.

Respectfully submitted,

Dated: June 23, 2005

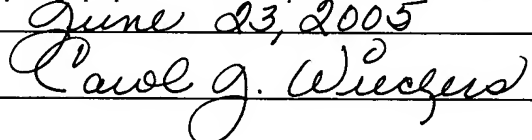
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